



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,774	01/12/2007	Thomas Szekeres	4301-1156	3787
<small>465</small> YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			<small>7590</small> EXAMINER KEYS, ROSALYND ANN	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 09/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,774

Applicant(s)

SZEKERES ET AL.

Examiner

ROSALYND KEYS

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/86)
Paper No(s)/Mail Date 2/9/06 & 1/19/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Status of Claims

1. Claims 1-30 are pending.
Claims 1-30 are rejected.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statements submitted on February 9, 2006 and January 19, 2007 have been considered by the examiner.

Claim Rejections - 35 USC § 112

4. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 provides for the use of at least one compound of claim 1, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 30 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7, 10, 11, 14, 15, 18-20, and 22-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Cushman et al. (WO 93/23357).

Cushman et al. disclose compounds having the claimed formula I (see entire disclosure, in particular pages 1, 3-5, 7-9, 12, 17, 24, 26, 29, 31, 34, Table II on pages 54-56, which contain compounds 6a-6c, 60, 6p, 6s, 6u, 6y, 16a, 16b, 16h-16j and 16l, pages 69, 70, 102 and claims 1-27). Cushman et al. teach that the compounds as useful as anti-cancer agents (see paragraph 1 on page 34). The use of phrases "free-

radical scavengers” and “cyclooxygenase-2 inhibitors” in the claims have not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

8. Claims 1, 2, 4, 6, 8-11, 14, 15, 18, 19, 23, 24, 26, 28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghai et al. (WO 01/21165 A1).

Ghai et al. teach a composition comprising hydroxylated or methoxylated resveratrol, which are compounds according to the claimed formula I (see entire disclosure, in particular pages 3, 4, 10-12 and claims 3-7). Resveratrol and its related compounds are taught to have many biological activities including antioxidant, anti-inflammatory, and anti-tumor promoting activity (see paragraph 2 on page 1).

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1, 4-6, 16, 17, 20, 21 and 23-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Gokaraju Ganga et al. (WO 2004/000302 A1).

Gokaraju Ganga et al. teach compounds having the claimed formula I (see entire disclosure, in particular pages 2-4, examples 1 and 2 and claims 1, 2, 4, and 12). The compounds may be used in pharmaceutical compositions as an antioxidant or free radical scavenger (see abstract). It is taught that free radicals play a role in the

progression of pathological disorders including cancer (see the second paragraph on page 1).

The use of phrase "cyclooxygenase-2 inhibitors" in the claims has not been treated with patentability. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
13. Claims 1, 8, 9, 12, 13, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushman et al. (WO 93/23357).

Cushman et al. teach the invention as described above. The claimed compounds are clearly suggested by the compounds of Cushman et al. (see entire disclosure in particular pages 1, 3-5, 7-9, 12, 17, 24, 26, 29, 31, 34, Table II on pages 54-56, 69, 70, 102 and claims 1-27). In particular Cushman et al. teach compounds, which are positional isomers of the claimed compounds (see for example compounds 6y, 6s. For example, a prior art compound may suggest its homologs because homologs often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties. Similarly, a known compound may suggest its analogs or isomers, either geometric isomers (cis v. trans) or position isomers (e.g. , ortho v. para). In all of these cases, however, the prior art teaches a specific, structurally-definable compound and

the question becomes whether the prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention. See *In re Jones*, 958 F.2d 347, 351, 21 USPQ2d 1941, 1944 (Fed. Cir. 1992); *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc) ("structural similarity between claimed and prior art subject matter . . . where the prior art gives reason or motivation to make the claimed compositions, creates a prima facie case of obviousness"), cert. denied, 500 U.S. 904 (1991).

14. Claims 1, 12, 13, 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Ghai et al. (WO 01/21165 A1).

Ghai et al. teach the invention as described above. The claimed compounds are clearly suggested by the compounds of Ghai et al. (see entire disclosure, in particular pages 3, 4, 10-12 and claims 3-7). In particular Ghai et al. teach compounds, which are positional isomers of the claimed compounds (see for example compound R-5 on page 3). Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

15. Claims 1, 12-15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokaraju Ganga et al. (WO 2004/000302 A1).

Gokaraju Ganga et al. teach the invention as described above. The claimed compounds are clearly suggested by the compounds of Gokaraju Ganga et al. (see entire disclosure, in particular pages 2-4, examples 1 and 2 and claims 1, 2, 4, and 12). In particular Ghai et al. teach compounds, which are positional isomers of the claimed compounds (see for example compound 1 on page 3). Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. *In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROSALYND KEYS whose telephone number is (571)272-0639. The examiner can normally be reached on M, W, F 8 am-3:30 pm; T, Th 5:30 am-7 am & 9:30 am-5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROSALYND KEYS/
Primary Examiner, Art Unit 1621

September 13, 2008